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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/210,472	12/14/1998	GYU-YEONG SON	1399.1001	5435

21171 7590 01/29/2003

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WASHINGTON, DC 20001

EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/210,472

Applicant(s)

SON ET AL. 107

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on Nov. 8, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/210,472 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Response to Arguments***

2. Applicant's arguments filed Oct. 4, 2002 have been fully considered but they are not persuasive.

In re pages 5-6, applicants state that Yuen et al (U.S. Patent Publication No. 2002/0012525A1) is not prior art under 35 U.S.C. §102(e) since the provisions of the American Inventors Protection Act which changed 35 U.S.C. §102(e) do not apply to this instant application because this application was not filed on or after November 29, 2000 and was not voluntarily published.

In response, U.S. application publications and U.S. patents, that did not result from the national stage of an international application (i.e., did not result from a 35 U.S.C. §371 application) and that do not claim the benefit of a prior international application, may be applied as prior art as of the actual filing date under 35 U.S.C. §111(a), or any filing date claimed under 35 U.S.C. §§119(e) or 120 according to the revisions of 35 U.S.C. §102(e) as amended by **the Intellectual Property and High Technology Technical Amendment Act of 2002 (H.R. 2215)**. Thus, Yuen et al (U.S. Patent Publication No. 2002/0012525A1) is prior art under 35 U.S.C. §102(e).

In re page 7, applicants argues that Yuen et al does not disclose or suggest the invention including "receiving without storing program guide information associated with the upcoming program" and "reserving, in response to the user command, the upcoming program for future recording using the received program guide information" as recited in claim 16.

In response, the examiner respectfully disagrees. Paragraph #0491 of Yuen et al teaches, by pressing the "i" button, the user can store the auxiliary information including program guide into RAM 33. The alleged "receiving without storing program guide information associated with the upcoming program" is met by not pressing the "i" button in Yuen et al. Yuen et al discloses in paragraphs #0514, #0515, #0516, #0517, #0518, and #0519 that the "PLUSCODE" included in the program guide can be used to reserve the upcoming program for future recording. Thus, the claimed "reserving, in response to the user command, the upcoming program for future recording using the received program guide information" is met by programming the VCR for unattended future recording using "PLUSCODE" of Yuen et al.

In re pages 7-8, applicants argue that Yuen et al does not disclose or suggest "receiving program guide information associated with the upcoming program, the program guide information being included with the program preview", "reserving, in response to the user command, the upcoming program for future recording using the received program guide information", and "wherein said reserving the upcoming program is only operable while the program preview is being broadcast" as recited in claim 81.

In response, the examiner respectfully disagrees. Yuen et al discloses in paragraphs #0507, #0508, #0509, and #0510 the claimed limitations “receiving program guide information associated with the upcoming program, the program guide information being included with the program preview”, “reserving, in response to the user command, the upcoming program for future recording using the received program guide information”, and “wherein said reserving the upcoming program is only operable while the program preview is being broadcast” as recited in claim 81.

In re pages 8-9, applicants argue that Yuen et al does not disclose the claimed “reserving, in response to the user command, the upcoming program for future recording using the received program guide information without the program guide information being displayed” as recited in claims 46, 51, 53, and 65.

In response, the examiner respectfully disagrees. Yuen et al discloses in paragraphs #0514, #0515, #0516, #0517, #0518, and #0519 that the “PLUSCODE” of the PRIs can be used to reserve the upcoming programs without displaying the program guide.

In re page 9, applicants argue that Yuen et al does not disclose the claimed “using a user input interface having user selection keys to generate a user command to reserve the upcoming program for future recording in accordance with a single action of one of the user selection keys being depressed to select and reserve the upcoming program” as recited in claim 50.

In response, the examiner respectfully disagrees. Yuen et al discloses in paragraph #0510 that reserving the upcoming programs can be performed by moving

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the cursor to the desired program and pressing the **Record** button. Thus, Yuen et al does indeed disclose the claimed “using a user input interface having user selection keys to generate a user command to reserve the upcoming program for future recording in accordance with a single action of one of the user selection keys being depressed to select and reserve the upcoming program” (pressing **Record** button of Yuen et al).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16-81 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 16 and 37 contain subject matter such as the combination of “receiving without storing program guide information associated with the upcoming program” and “reserving, in response to the user command, the upcoming program for future recording **using the received program guide information**” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. How can upcoming programs being reserved by using program guide information without storing the program guide information?

Independent claim 24 contains subject matter such as the combination of “a controller to reserve the upcoming program for future recording using **the program guide information**” and “wherein **the program guide information** is not stored in said memory until the user command is received” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 50 and 52 contain subject matter “reserving, in response to the user command, the upcoming program for future recording using **the received program guide information**” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 81 contains subject matter “reserving, in response to the user command, the upcoming program for future recording using **the received program guide information**” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The remaining claims are dependent on the rejected base claims 16, 24, 37, 50, 52, and 81 and therefore inherit the deficiencies thereof.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 16-17, 19-26, 28-35, 37-54, 56-62, and 64-81 are rejected under 35

U.S.C. 102(e) as being anticipated by Yuen et al (US 2002/0012525 A1) as set forth in paragraph #3 of the last Office Action.

Regarding claim 16, Yuen et al discloses a method of reserved recording of an upcoming program while a program preview of the upcoming program is being broadcast (Fig. 5), the method comprising receiving without storing program guide information associated with the upcoming program (page 41, paragraph #0491 and page 47, paragraph #0565); receiving, during the broadcast of the program preview (page 47, paragraph #0565), a user command to reserve the upcoming program for future recording; and reserving, in response to the user command, the upcoming program for future recording using the received program guide information (page 60, from paragraph #0708 to page 61, paragraph #0735).

Regarding claim 17, Yuen et al discloses the claimed wherein the program guide information is embedded in the program preview (page 47, paragraph #0565).

Regarding claim 19, Yuen et al discloses the claimed wherein said receiving the program guide information comprises automatically receiving the program guide information for the upcoming program to be broadcast at the future time without another



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user command requesting the program guide information (page 41, paragraph #0506 and page 42, paragraph #0507).

Regarding claim 20, Yuen et al discloses the claimed wherein said reserving the upcoming program comprises reserving the upcoming program without retrieving stored program guide information from a memory (page 41, paragraph #0941).

Regarding claim 21, Yuen et al discloses the claimed prompting a user for the user command to reserve the upcoming program for future recording during the broadcast of the program preview (page 47, paragraph #0565 and from page 60, paragraph #0708 to page 61, paragraph #0735).

Regarding claim 22, Yuen et al discloses the claimed providing a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed (page 42, paragraph #0510).

Regarding claim 23, Yuen et al discloses the claimed wherein the user command is generated in response to a single action of a user (page 42, paragraph #0510).

Regarding claim 24, Yuen et al discloses a program recording device (Fig. 5) for reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast, the device comprising a memory (RAM 33, page 41, paragraph #0506 and page 42, paragraph #0507) to store program guide information associated with the upcoming program; a user interface (page 42, paragraph #0510 and page 47, paragraph #0565) to receive, during the broadcast of the program preview, a user command to reserve the upcoming program for future recording; a controller (the

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microprocessor controller 31, page 42, paragraph #0510 and from page 60, paragraph #0708 to page 61, paragraph #0735); and wherein the program guide information is not stored in said memory until the user command is received (page 41, paragraph #0491).

Regarding claim 25, Yuen et al discloses a receiver (page 41, paragraph #0506 and page 42, paragraph #0507) to receive the program guide information.

Regarding claim 26, Yuen et al discloses the claimed wherein the program guide information is embedded in the program preview (page 47, paragraph #0565).

Regarding claim 28, Yuen et al discloses the claimed wherein said receiving the program guide information comprises automatically receiving the program guide information for the upcoming program to be broadcast at the future time without another user command requesting the program guide information (page 41, paragraph #0506 and page 42, paragraph #0507).

Regarding claim 29, Yuen et al discloses the claimed wherein the program guide information is not stored as it is received by said receiver unless in response to the user command to reserve the upcoming program for future recording (page 42, paragraph #0510).

Regarding claim 30, Yuen et al discloses the claimed wherein said controller further prompts a user for the user command during the broadcast of the program preview (page 47, paragraph #0565 and from page 60, paragraph #0708 to page 61, paragraph #0735).

Regarding claim 31, Yuen et al discloses a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed (page 42, paragraph #0510).

Regarding claim 32, Yuen et al discloses wherein the user command is generated in response to a single action of a user (page 42, paragraph #0510).

Regarding claim 33, Yuen et al discloses a recording unit that is operable to record the upcoming program in accordance with the program guide information stored in the memory (page 42, paragraph #0510).

Regarding claim 34, Yuen et al discloses wherein the recording unit comprises a video cassette recorder (page 42, paragraph #0510).

Regarding claim 35, Yuen et al discloses wherein said recording unit comprises a television having a recording unit (page 10, paragraph #0197).

Regarding claim 37, Yuen et al discloses a computer readable storage medium (page 11, paragraph #0199) encoded with a computer program to implement a method of reserved recording of the upcoming program while a program preview for an upcoming program is being broadcast (Fig. 5), the method comprising receiving without storing program guide information associated with the upcoming program (page 41, paragraph #0491 and page 47, paragraph #0565); receiving, during the broadcast of the program preview (page 47, paragraph #0565), a user command to reserve the upcoming program for future recording; and reserving, in response to the user command, the upcoming program for future recording using the received program guide information (page 60, from paragraph #0708 to page 61, paragraph #0735).

Regarding claim 38, Yuen et al discloses the claimed wherein the program guide information is embedded in the program preview (page 47, paragraph #0565).

Regarding claim 39, Yuen et al discloses the claimed prompting a user for the user command during the broadcast of the program preview (page 47, paragraph #0565 and from page 60, paragraph #0708 to page 61, paragraph #0735).

Regarding claim 40, Yuen et al discloses the claimed wherein said receiving the user command comprises detecting an input from a user input interface having user selection keys (page 42, paragraph #0510) and the user command is generated in response to only one of the user selection keys being depressed (page 42, paragraph #0510).

Regarding claim 42, Yuen et al discloses the claimed wherein said receiving the program guide information comprises automatically receiving the program guide information for the upcoming program to be broadcast at the future time without another user command requesting the program guide information (page 41, paragraph #0506 and page 42, paragraph #0507).

Regarding claim 43, Yuen et al discloses the claimed wherein said reserving the upcoming program comprises reserving the upcoming program without retrieving stored program guide information from a memory (page 41, paragraph #0941).

Regarding claim 44, Yuen et al discloses the claimed wherein the user command is generated in response to a single action of a user (page 42, paragraph #0510).

Regarding claim 45, Yuen et al discloses the claimed recording the upcoming program in accordance with the program guide information (page 42, paragraph #0510).

Regarding claim 46, Yuen et al discloses a method of reserved recording of an upcoming program while a program preview of the upcoming program is being broadcast (Fig. 5), the method comprising receiving the program preview including program guide information associated with the upcoming program (page 47, paragraph #0565); displaying the program preview (page 47, paragraph #0570); receiving, during the broadcast of the program preview (page 47, paragraphs #0565 and #0566), a user command to reserve the upcoming program for future recording while the program guide information is being received; and reserving, in response to the user command, the upcoming program for future recording using the received program guide information without the program guide information being displayed (page 43 and page 60, from paragraph #0708 to page 61, paragraph #0735).

Regarding claim 47, Yuen et al discloses the claimed receiving a plurality of program previews for a plurality of upcoming programs (page 41, paragraph #0506, page 42, paragraph #0507 and page 47, paragraph #0565)); and storing the plurality of program previews (page 42, paragraph #0508 and page 47, paragraph #0566); wherein said displaying the program preview comprises sequentially replaying the stored plurality of program previews (page 47, paragraph #0570).

Regarding claim 48, Yuen et al discloses the claimed providing a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed (page 42, paragraph #0510).

Regarding claim 49, Yuen et al discloses the claimed wherein the user command is generated in response to a single action of a user (page 42, paragraph #0510).

Claim 50 is rejected for the same reasons as discussed in claims 16 and 22 above and, additionally, Yuen et al discloses that the reserving the upcoming program is performed accordance with a single action of one of the user selection keys being depressed (page 42, paragraph #0510).

Claim 51 is rejected for the same reasons as discussed in claim 23 above.

Claim 52 is rejected for the same reasons as discussed in claims 37, 40, and 50 above.

Regarding claim 53, Yuen et al also discloses the claimed wherein the user command is generated in response to the single action of a user while the program guide information is not displayed (page 43).

Claim 54 is rejected for the same reasons as discussed in claim 17 above.

Claims 56-60 are rejected for the same reasons as discussed in claims 19-23 above, respectively.

Claims 61-62 are rejected for the same reasons as discussed in claims 25-26 above, respectively.

Claim 64 is rejected for the same reasons as discussed in claim 28 above.

Claim 65 is rejected for the same reasons as discussed in claim 29 above.

Claims 66-69 are rejected for the same reasons as discussed in claims 30-33 above, respectively.

Claims 70-77 are rejected for the same reasons as discussed in claims 38-45 above, respectively.

Claim 81 is rejected for the same reasons as discussed in claims 16-17 above.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 18, 27, 36, 55, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen et al (US 2002/0012525 A1) as set forth in paragraph #5 of the last Office Action.

Regarding claim 18, Yuen et al discloses all the features of the instant invention except providing that the program preview comprises audio data.

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The capability of transmitting the audio data along with the video data is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known audio data with the video data of the program preview in order to increase the quality of the program preview by adding audio data.

Claim 27 is rejected for the same reasons as discussed in claim 18 above.

Regarding claim 36, Yuen et al discloses all the features of the instant invention except for providing wherein the recording unit comprises a Hard Disc drive.

It is noted that the capability of recording/reproducing video signal on/from the Hard Disk drive is well known and old in the art and again Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known Hard Disc drive into Yuen et al's system in order to decrease the time in access the desired video signal because Hard Disc drive has random access capability.

Claim 55 is rejected for the same reasons as discussed in claim 18 above.

Claim 63 is rejected for the same reasons as discussed in claim 27 above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

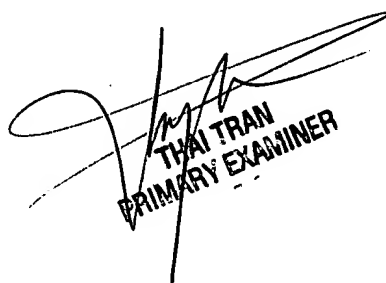


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

TTQ

January 25, 2003



THAI TRAN  
PRIMARY EXAMINER